

**BASIS FOR THE AMENDMENT**

Claim 24 has been canceled.

The amendment of the claims and specification are supported by the priority document (which is incorporated by reference into the specification, see page 154, last paragraph) and by the specification as originally filed.

No new matter is believed to have been added by entry of this amendment. Entry and favorable reconsideration are respectfully requested.

Upon entry of this amendment Claims 1, 8, 10, 13, 14, 21-23 and 26-28 will now be active in this application.

**REMARKS**

Applicants respectfully request reconsideration of the application, as amended, in view of the following remarks.

The rejections of Claim 24 are moot in view of the cancellation of Claim 24.

Applicants submit a Rule 132 Declaration and a revised English translation correcting translational errors. The Examiner is requested to consider the revisions to the translation.

The rejection of Claims 1, 8, 10, 13, 14, 21-23 and 26-28 under 35 USC 112, 1<sup>st</sup> paragraph, is traversed.

Regarding Claims 1, 21 and 26, the language of (or analogous language)

wherein the toner particles are prepared by a method comprising

- dissolving or dispersing a toner composition, comprising
  - (i) at least a polyester prepolymer (A) having an isocyanate group, and being capable of reacting with an active hydrogen;
  - (ii) an amine (B) as a compound having an active hydrogen,
  - (iii) said second resin having a weight average molecular weight of from 2,000 to 10,000,
  - (iv) said colorant, and
  - (v) said release agent, in an organic solvent, to obtain an oil phase liquid;
- dispersing the oil phase liquid in an aqueous medium comprising said particulate material while subjecting the polyester prepolymer (A) to an addition polymerization reaction using said compound having said active hydrogen as a cross-linking agent, extending agent or both, to prepare said urea-modified polyester resin and to prepare a dispersion;
- removing at least the organic solvent from the dispersion to prepare the toner particles comprising the binder resin;
- washing the toner particles; and
- drying the toner particles

is supported by the English translation of the priority document, for example in paragraphs [0005, 0011-0026 and 0045].

The Examiner states that there is no disclosure of subjecting a polyester prepolymer (A) to form a urea-modified polyester resin. However, Applicants wish to draw the Examiner's attention in particular to paragraphs [0011 to 0013] of the translation of the Japanese priority document. (See also pages 15-16 of the specification.) The polyester prepolymer which has an isocyanate group is reacted with an amine (B), for example a diamine (B1) (see paragraph [0019] of the translation), which has an active hydrogen. Thus, it is the polyester prepolymer which is capable of reacting with an active hydrogen. If a diamine is used, first the isocyanate group is reacted with an amine group of the diamine resulting in formation of an alkyl urea. The other amine group of the diamine is reacted with the isocyanate group of another molecule of the polyester prepolymer to obtain a urea-modified polyester resin.

Further, the Examiner states that "polyester prepolymer (A)" is broader than "modified polyester resin" because, according to the Examiner, it includes "non-modified" polyester resin. However, the polyester prepolymer having an isocyanate group as claimed does not include non-modified polyester resins.

Thus, the rejection of Claims 1, 8, 10, 13, 14, 21-23 and 26-28 under 35 USC 112, 1<sup>st</sup> paragraph, should be withdrawn.

This case qualifies for the exemption under 102(e)/103(c) because Yagi, as well as Emoto and the present invention were commonly owned by Ricoh Company Limited at the time the present invention was made. The 102(a) dates of Yagi and Emoto (July 24, 2003 and August 14, 2003) are overcome by filing the Certified English Translation of the Japanese priority document JP 2002-365782, filed December 17, 2002. See also the revised

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English translation and Rule 132 Declaration. Applicants have thereby perfected their claim to priority. The claims have been amended to be consistent with the priority application.

Therefore, the rejections of the claims over Yagi and Emoto are believed to be unsustainable and should be withdrawn.

Regarding the **provisional** double patenting rejection, the MPEP instructs the Examiner to withdraw the provisional rejection if it is the only issue remaining in one case and convert the provisional rejection in the other application to a double patenting rejection. MPEP 822.01.

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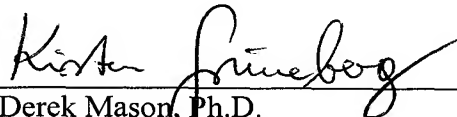
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This application presents allowable subject matter, and the Examiner is kindly requested to pass it to issue. Should the Examiner have any questions regarding the claims or otherwise wish to discuss this case, he is kindly invited to contact Applicants' below-signed representative, who would be happy to provide any assistance deemed necessary in speeding this application to allowance.

Respectfully submitted,

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